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10/783,169

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHANE D. PANNELL and MICHAEL K. WRIGLEY

Appeal 2009-003415
Application 10/783,169
Technology Center 3700

Decided:¹ July 22, 2009

Before LINDA E. HORNER, STEVEN D.A. McCARTHY
and FRED A. SILVERBERG, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 (2008), begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or the Notification Date (electronic delivery).

1 The Appellants appeal under 35 U.S.C. § 134 (2002) from the
2 Examiner's decision finally rejecting claims 74-89 under 35 U.S.C. § 112,
3 ¶ 1 (2002) as failing to comply with the enablement requirement and under
4 35 U.S.C. § 112, ¶ 2 (2002) as being indefinite. We have jurisdiction under
5 35 U.S.C. § 6(b) (2002).

6 We REVERSE.

7 Claim 74 is typical of the claims on appeal:

8
9 74. A chemical distribution system,
10 comprising:
11 a residential home;
12 a yard in an exposed area adjacent to the
13 residential home including a fence, gate, shrub,
14 tree, swimming pool, patio, garden, grass area,
15 play area, and concrete pad;
16 a hollow tubing disposed around each of a
17 plurality of target areas in the yard including the
18 fence, shrub, tree, garden, and grass area, the
19 tubing transporting a chemical solution selected
20 from the group consisting of pesticides, herbicides,
21 fertilizers, animal retardants, and vegetation pre-
22 emergence, the tubing being made of a chemical
23 resistant material selected from the group
24 consisting of polyethylene, polyurethane, nylon,
25 and polypropylene, with a pressure rating of at
26 least sixty pounds per square inch, the tubing
27 having an inside diameter ranging from one-eighth
28 inch to three-fourth inch and an outside diameter
29 ranging from one-fourth inch to one inch, *the*
30 *tubing having a plurality of openings cut through*
31 *its wall structure at selected points in accordance*
32 *with government regulations and manufacturer's*
33 *recommendations* and corresponding to each of the
34 plurality of target areas, the tubing including a
35 plurality of "Y" and elbow couplings for changing

1 direction of the tubing to cover the plurality of
2 target areas, the tubing being routed up and down
3 *structures* that extend vertically above ground
4 secured with pressure-fit clamps and otherwise laid
5 above ground;

6 a plurality of spray nozzles inserted into the
7 openings in the tubing for distributing the chemical
8 solution to the selected target areas, the spray
9 nozzles being circular in shape, made of non-
10 corrosive metal and having adjustable flow rates
11 and spray patterns;

12 a truck for transporting the chemical
13 solution to the residential home, the truck
14 including a hose for transporting the chemical
15 solution to the tubing;

16 first and second junction boxes disposed
17 below ground in a front area of the residential
18 home;

19 a first pressure regulator connected to the
20 tubing within the first junction box for regulating
21 pressure of the chemical solution;

22 a first hook-up port disposed within the first
23 junction box and having an output connected to a
24 first end of the tubing, the first hook-up port
25 including a lever arm which lays horizontal within
26 the junction box when not in use and rotates ninety
27 degrees to a vertical position so that a fitting on an
28 end of the lever arm extends above ground when
29 connected to the hose from the truck;

30 a second hook-up port disposed within the
31 second junction box and having an output
32 connected to a second end of the tubing, the
33 second hook-up port including a lever arm which
34 lays horizontal within the junction box when not in
35 use and rotates ninety degrees to a vertical position
36 so that a fitting on an end of the lever arm extends
37 above ground when connected to the hose from the
38 truck, wherein the first and second hook-up ports

1 form a closed system to equalize pressure and
2 distribution of the chemical solution;
3 a second pressure regulator coupled in a
4 portion of the tubing which is located in a rear
5 portion of the yard for regulating pressure of the
6 chemical solution; and
7 a booster pump coupled in a portion of the
8 tubing which is located in the rear portion of the
9 yard for increasing the pressure of the chemical
10 solution.
11

12 [Emphasis added.] Independent claims 78 and 84 each recite “the tubing
13 having a plurality of openings cut through a first portion of its wall structure
14 in accordance with government regulations and manufacturer’s
15 recommendations.”

16 The Examiner objects to the drawings. The Appellants seek to appeal
17 this objection. (Br. 13 and 16-18.) Objections to the drawings are
18 reviewable by petition under 37 C.F.R. § 1.181. (See MANUAL OF PATENT
19 EXAMINATION PROCEDURE §§ 1002 and 1201.) The Board does not exercise
20 jurisdiction over matters reviewable by petition. *In re Mindick*, 371 F.2d
21 892, 894 (CCPA 1967).

22 The Examiner concludes that claims 74, 78 and 84 are indefinite
23 because the Specification fails to identify the government regulations and
24 manufacturer’s recommendations with which the plurality of openings cut
25 through the wall structure of the hose must be in accord. (Ans. 5.) In
26 addition, the Examiner concludes that claims 74, 78 and 84 are indefinite
27 because the recited government regulations and manufacturer’s
28 recommendations are subject to change during the life of any patent granted
29 on the underlying application. (*Id.*) The Appellants contend that the term

1 “government regulations and manufacturer’s recommendations” is not
2 indefinite because the term must be interpreted as of the filing date and
3 because the relevant regulations and recommendations existing as of the
4 filing date can be readily determined. (Br. 21.) Therefore, one issue raised
5 by this appeal is:

6 Have the Appellants shown that the Examiner erred in
7 concluding that claims 74, 78 and 84 are indefinite because the
8 Specification fails to identify the government regulations and
9 manufacturer’s recommendations with which the plurality of
10 openings cut through the wall structure of the hose must be in
11 accord; or because those government regulations and
12 manufacturer’s recommendations might change?

13 The language of a claim satisfies § 112, ¶ 2 if “one skilled in the art
14 would understand the bounds of the claim when read in light of the
15 specification.” *Exxon Research & Eng’g Co. v. United States*, 265 F.3d
16 1371, 1375 (Fed. Cir. 2001). A claim is indefinite if the language of the
17 claim is susceptible of no reasonable interpretation. *Id.* A claim under
18 examination susceptible of more than one reasonable interpretation may be
19 indefinite if the scope of the claim differs significantly depending on which
20 of the reasonable interpretations one adopts. *Ex Parte Miyazaki*, 89
21 USPQ2d 1207, 1211-12 (BPAI 2008).

22 The term “manufacturer’s recommendations” recited in claims 74, 78
23 and 84 is limited to the chemical solution manufacturer’s recommendations.
24 The Appellants’ Specification states that:

25 A spray nozzle or outlet 58 is inserted into
26 each hole of tubing 50 along foundation wall 52
27 for dispensing and applying the chemical pesticide

1 to the open target areas proximate to building
2 structure 12 along foundation wall 52. . . . The
3 selected locations for punch holes depend upon the
4 pesticide manufacturer's recommended application
5 instructions and any external structures 36 adjacent
6 to or in proximity of foundation wall 52 that could
7 interfere with the spraying pattern or otherwise
8 unnecessarily be exposed to the chemical
9 pesticide. The spray nozzles 58 are inserted into
10 tubing 50 along foundation wall 52 for an even,
11 complete, and directed coverage of the chemical
12 pesticide to the outside ground areas proximate to
13 building structure 12, in accordance with
14 government regulations and manufacturer's
15 recommendations.

16 (Spec. 8, ¶ 00017; *see also id.* 10, ¶ [00021].) The Specification's consistent
17 use of the term "manufacturer's recommendations" in contexts implying that
18 the recommendations are those of the chemical solution manufacturer
19 similarly limit the term "manufacturer's recommendations" as used in claims
20 74, 78 and 84.

21 In addition, the term "in accordance with government regulations and
22 manufacturer's recommendations" will be limited to those regulations and
23 recommendations applicable to the distribution of a particular chemical
24 solution. To interpret the term more broadly would render the term
25 superfluous, since any arrangement of openings in the wall of the tubing
26 would be trivially in accordance with any *inapplicable* regulation or
27 recommendation. For similar reasons, one of ordinary skill in the art would
28 understand the term "government regulations" to be limited to the
29 regulations in force in the jurisdiction where the chemical distribution
30 systems recited in claims 74, 78 or 84 are to be used.

1 Claim language is to be interpreted as it would have been understood
2 by one of ordinary skill in the art at the time of the invention. Ordinarily,
3 this implies that claim language is to be interpreted as it would be
4 understood as of the effective filing date. *Phillips v. AWH Corp.*, 415 F.3d
5 1303, 1313 (Fed. Cir. 2005) (en banc). Likewise, definiteness under § 112,
6 ¶ 2 is determined as of the filing date. *W.L. Gore & Assoc. v. Garlock, Inc.*,
7 721 F.2d 1540, 1556 (Fed. Cir. 1983). Therefore, the “government
8 regulations and manufacturer’s recommendations” recited in claims 74, 78
9 and 84 are the government regulations and manufacturer’s recommendations
10 in effect as of the filing date. Any possibility that the regulations or
11 recommendations might have changed subsequent to the filing date or may
12 change in the future has no bearing on the scope or definiteness of claims 74,
13 78 and 84.

14 The Appellants are correct in asserting that the government
15 regulations, and the chemical solution manufacturer’s recommendations,
16 applicable to the distribution of a particular chemical solution in a particular
17 jurisdiction as of the filing date of the application would have been readily
18 ascertainable. In addition, the government regulations and the chemical
19 solution manufacturer’s recommendations would have been reasonably
20 pertinent to the problem of distributing the chemical solution and, as such,
21 within the relevant prior art known to one of ordinary skill in the art. *Cf. In*
22 *re GPAC*, 57 F.3d 1573, 1577 (Fed. Cir. 1995) (defining the “relevant prior
23 art” to include art “reasonably pertinent to the particular problem with which
24 the inventor was involved”); *id.*, 57 F.3d at 1579 (defining one of ordinary
25 skill in the art as a “hypothetical person who is presumed to know the
26 relevant prior art.”). Indeed, a prudent building contractor or a prudent

1 chemical solution distribution contractor likely would inquire into the
2 applicable government regulations and manufacturer's recommendations
3 before making or using a system such as that recited in claim 74, 78 or 84
4 even absent a need to interpret those claims. In other words, one of ordinary
5 skill in the art would have a reasonable understanding of the scope and
6 meaning of the term "in accordance with government regulations and
7 manufacturer's recommendations."

8 Claim language need only be as accurate as the claimed subject matter
9 permits. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565,
10 1576 (Fed. Cir. 1986). Since the chemical distribution systems recited in
11 claims 74, 78 and 84 may be constructed in various jurisdictions subject to
12 various government regulatory schemes, and since the systems may be used
13 to distribute many types of chemical solutions subject to different
14 manufacturer's recommendations, the recitation that the tubing is to have a
15 plurality of openings "in accordance with government regulations and
16 manufacturer's recommendations" is as accurate as the subject matter
17 permits.

18 Therefore, the Appellants have shown that the Examiner erred in
19 concluding that claims 74, 78 and 84 are indefinite because the Specification
20 fails to identify the government regulations and manufacturer's
21 recommendations with which the plurality of openings cut through the wall
22 structure of the hose must be in accord; or because those government
23 regulations and manufacturer's recommendations might change.

24 The Examiner also concludes that the recitation in claim 74 that the
25 tubing includes "a plurality of 'Y' and elbow couplings for changing
26 direction of the tubing to cover the plurality of target areas, the tubing being

1 routed up and down *structures* that extend vertically above ground secured
2 with pressure-fit clamps and otherwise laid above ground” [emphasis added]
3 is indefinite because the term “structures” appears to be a double inclusion
4 of the previously-recited residential home. (Ans. 3.) The Appellants
5 contend that the term “structures” could refer to a fence or stakes and is not
6 limited to the residential home. (Br. 22.) Therefore, another issue raised by
7 this appeal is:

8 Have the Appellants shown that the Examiner erred in
9 concluding that claim 74 is indefinite because the term
10 “structures” as used in claim 74 is a double inclusion of the
11 previously-recited residential home?

12 Double inclusion, that is, the recitation of the same structure twice in a
13 claim using different terminology, does not render a claim indefinite *per se*.
14 *In re Kelley*, 305 F.2d 909, 916 (CCPA 1962). Even so, the term
15 “structures” as used in claim 74 is not a double inclusion of the residential
16 home. The recitation of the term “structures” in the plural indicates that the
17 Appellants did not intend to limit the term to the residential home. The
18 Appellants use the similar term “external structures” in the Specification to
19 refer not only to the residential home 12, but also, for example, to the fence
20 16, the gate 18, the shrubs 20 and the tree 22. (*See, e.g.*, Spec. 5, ¶ 00012.)
21 In view of this usage, the term “structures” is broad, encompassing far more
22 than merely the residential home.

23 The Appellants have shown that the Examiner erred in concluding that
24 claim 74 is indefinite because the term “structures” as used in claim 74 is a
25 double inclusion of the previously-recited residential home. Therefore, the

1 Appellants have shown that the Examiner erred in rejecting claims 74, 78
2 and 84, and their dependent claims, under § 112, ¶ 2, as being indefinite.

3 The Examiner concludes that the Specification fails to enable claims
4 74, 78 and 84 because the Specification fails to identify the government
5 regulations and manufacturer's recommendations with which the plurality of
6 openings cut through the wall structure of the hose must be in accord. (Ans.
7 3.) The Appellants contend that the Specification enables claims 74, 78 and
8 84 because one of ordinary skill in the art "would easily understand how to
9 ascertain the relevant government regulations and manufacturer's
10 recommendations." (Br. 18.) Therefore, a final issue raised by this appeal
11 is:

12 Have the Appellants shown that the Examiner erred in
13 concluding that the subject matter of claims 74, 78 and 84 is not
14 enabled because the Specification fails to identify the
15 government regulations and manufacturer's recommendations
16 with which the plurality of openings cut through the wall
17 structure of the hose must be in accord?

18 Our reviewing court has described the enablement requirement as
19 follows:

20 Enablement is a legal determination of
21 whether a patent enables one skilled in the art to
22 make and use the claimed invention[;] is not
23 precluded even if some experimentation is
24 necessary, although the amount of experimentation
25 needed must not be duly extensive[;] and is
26 determined as of the filing date of the patent
27 application. . . . Furthermore, a patent need not
28 teach, and preferably omits, what is well known in
29 the art.

1 *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed.
2 Cir. 1986) (citations omitted).

3 As discussed above, the applicable government regulations and
4 manufacturer's recommendations would have been readily ascertainable;
5 would have been reasonably pertinent to the particular problem with which
6 the Appellants were involved; and consequently would have been known to
7 the hypothetical one of ordinary skill in the art. As such, the Appellants in
8 the context of the present application were not required to identify or
9 reproduce particular government regulations or manufacturer's
10 recommendations in the Specification in order to enable claims 74, 78 and
11 84.

12 Therefore, the Appellants have shown that the Examiner erred in
13 concluding that the subject matter of claims 74, 78 and 84 is not enabled
14 because the Specification fails to identify the government regulations and
15 manufacturer's recommendations with which the plurality of openings cut
16 through the wall structure of the hose must be in accord. The Appellants
17 have shown that the Examiner erred in rejecting independent claims 74, 78
18 and 84, along with their dependent claims, under § 112, ¶ 1 for failing to
19 comply with the enablement requirement.

20
21 DECISION

22 We REVERSE the Examiner's decision rejecting claims 74-89.

23
24 REVERSED

Appeal 2009-003415
Application 10/783,169

1 mls

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